

## **REMARKS**

### **Status of Claims**

Upon entry of this amendment, claims 1-18 and 20-38 will remain pending, claims 1, 2, 6, 7, 9, 12, 15, 16, and 38 being independent.

### **Summary of the Final Office Action**

Claims 1-6, 13-18, and 20-27 are allowed.

Claims 7-12 and 28-30 are rejected under 35 USC §102(b) as being anticipated by MYERS et al. (U.S. Patent No. 5,735,536, hereinafter "MYERS").

### **Summary of Amendment and Reply to Office Action**

#### **A. Summary of Amendment**

In the amendment above, Applicant has amended each of the rejected independent claims, viz., claims 7, 9, and 12, to call for the lateral and medial flanges of the in-line skate of the invention to be distinct parts of a multiple-part chassis. Support for the subject matter to which the amended claims encompass can be found, for example, on page 9, lines 12-16.

Further, for the purpose of ensuring compliance with 37 CFR §1.83(a), Applicant has attached a replacement sheet of drawing which includes Fig. 2a. Fig. 2a illustrates the subject matter described on page 9, lines 12-16, in which the flanges of the chassis have L-shaped transverse sections and in which the flanges are connected together by the small arm of each "L". No new matter is believed to be added by Fig. 2a. However, should the Examiner prefer a different technique in illustrating the subject matter of page 9, lines 12-16, such as a broken line showing, Applicant requests an opportunity to provide a revised drawing.

The specification has been amended above to refer to Fig. 2a.

In addition, new claims 31-36 have been added, which also refer to the aforementioned subject matter.

In addition, new claim 37 depends from independent claim 9 and refers to each of the lateral and medial intermediate portions having at least an outwardly raised segment that extends and varies in height lengthwise.

Lastly, new independent claim 38 is similar to claim 1, but adds the word "single" in the final subparagraph (*i.e.*, "said stiffening rib having been made by pressing, extending longitudinally other than in a *single* straight line").

**B. Reply to Office Action**

Applicant kindly requests that the rejection of claims 7-12 and 28-30 under 35 USC §102(b), based solely upon the disclosure of MYERS, be reconsidered and withdrawn, at least for the following reasons.

In independent claim 12, Applicant describes the in-line skate of his invention to include, *inter alia*, medial and lateral flanges, each such flange including respective top, bottom and intermediate portions, whereby at least the intermediate portion of the lateral flange (*i.e.*, the flange on the outer side of the foot), having been made by pressing, is substantially non-coplanar with the bottom portion of the lateral flange, and whereby the intermediate portion of the lateral flange is spaced apart from the intermediate portion of the medial flange by a distance (a "second" distance) which is different from the distance that the bottom portions of the lateral and medial flanges are spaced apart.

In independent claims 7 and 9, Applicant describes the intermediate portions of *both* lateral and medial flanges to have been made by pressing.

The frame (*i.e.*, "chassis") of MYERS is *not* made by pressing. Instead, it is made by *extrusion*.

The sentence bridging pages 3 and 4 of the Office action to which Applicant is herewith replying cites MYERS' passage in column 5, lines 44-64 that "further embodiments may be formed by other suitable manufacturing processes, including, but not limited to molding, casting, stamping and the like."

In spite of the mention of such processes, characterized as "suitable," such processes are inconsistent with the remainder of MYERS' disclosure. Therefore, by providing no elaboration

at all as to how these other "suitable" processes could be implemented by one skilled in the art, particularly to include a chassis having the so-called "interlocking channel system (ICS)" (initially summarized at column 2, lines 36-60 and additionally described at column 5, lines 7-65), MYERS fails to provide an enabling disclosure for a skate chassis that would be made by means of such processes.

That is, the aforementioned passage that mentions "molding, casting, stamping and the like" refers to "further embodiments." However, the only chassis disclosed by MYERS is one that requires a feature that is incompatible with the aforementioned "further embodiments."

Thus, MYERS only describes the *extrusion* technique (not molding; not stamping; not "and the like") as being used for manufacturing a frame having the necessary straight, precisely formed ribs 30, 30a, 30b for sliding cooperation with the channels 50, 69 of the boot support members 12, 14.

It is quite important for ensuring the adjustability feature of MYERS' frame that the frame include MYERS' ICS feature.

This ICS system employs raised ribs 30 (or rib portions 30a, 30b) which extend along the upper extent of the exterior surface 28 of the side walls 25, 26 of the body 10 of the chassis/frame 3. The ribs on the frame (see Figs. 2 and 3, for example) interact with channels 50, 69 of heel and toe boot supporting members 12 and 14, respectively (see Figs. 4, 5a, 5b, 6, and 7, for example, and column 8, lines 1-11) so that such boot support members 12, 14 can slide along the ribs 30 of the ICS to thereby provide the adjustability necessary in the MYERS skate.

It is the intention of MYERS that the body of his chassis have a *substantially constant transverse cross section along its length* (see column 3, lines 1-3 and column 4, lines 16-17), *i.e.*, thereby enabling the chassis to be manufactured by an extrusion process, thereby resulting in a frame that is typically stronger than a frame made by the other two known construction

techniques described in Applicant's specification.

MYERS explains that the ribs are straight and define a cross-sectional shape that remains constant along the length dimension of the body 10 of the chassis/frame 3. See column 5, lines 28-43. Further, beginning at column 5, line 44, MYERS explains that extrusion is "highly efficient and cost effective" for articles that have constant cross-sectional dimensions such as that of the body 10 of the chassis/frame 3.

As stated in *In re Donohue*, 226 USPQ 619, 621 (Fed. Cir. 1985):

It is well settled that prior art under 35 U.S.C. §102(b) must sufficiently describe the claimed invention to have placed the public in possession of it.

In addition to MYERS failing to provide an enabling disclosure as to how his skate chassis could be made using a technique other than extrusion, as explained above, Applicant's original disclosure has already offered reasons why those knowledgeable of prior art skate frames do not rely upon molding or pressing for skate frames.

That is, on page 3, lines 12-14 of Applicant's specification, he explains that insufficient precision is provided by prior art skates that rely upon a molding technique. Similarly, it would be apparent to those skilled in the art, as well as to those not even skilled in the art, that stamping or pressing a metallic object, *i.e.*, so as to deform it, cannot be relied upon to create ribs like those disclosed by MYERS for sliding cooperation with channels of boot-supporting members that are necessary in the ICS system.

Therefore, the bare mention by MYERS of a pressing technique being employed rather than, or in addition to, extrusion, without providing an enabling disclosure, does not provide a teaching that places the public in possession of a skate frame using a pressing technique. It fails to answer how pressing, for example, would enable one to manufacture a skate chassis that

would meet the requirements described by MYERS in spite of known disadvantages summarized by Applicant in his application.

It is known in the art that extrusion can be used to maintain close tolerances for articles having a constant cross section. The use of a molding technique, *e.g.*, to make a skate frame would require the resolution of problems, such as deformation, when the article is removed from the mold or when the article is further machined.

Similarly, manufacturing a skate frame by pressing also presents problems that would present unresolved problems to those skilled in the art, such that using pressing rather than extrusion, is insufficiently disclosed by MYERS. As an example, ribs and grooves having the close fitting and slight transverse dimensions of the ribs 30 in the toe and heel portions of the frame of MYERS could not be made by pressing.

Dependent claim 11 includes all the limitations of parent claim 9 and, therefore, Applicant requests that the rejection of claim 11 be reversed for the reasons given above.

In addition, claim 11 includes the limitation that "said lateral intermediate portion has a longitudinally curved contour."

This limitation encompasses, *e.g.*, the embodiments described on page 12, lines 8-11 of Applicant's specification (shown in Figs. 1-10), as follows: "Each of the ribs 8, 18, and 28 of the examples of the invention described above extends longitudinally at a variable height relative to a line that connects the opposite ends of the ribs." That is, "extending longitudinally at a variable height ...", particularly coupled with the drawings (see, *e.g.*, 1, 4, and 7), supports the limitation recited in claim 11.

Because claim 11 calls for the intermediate portion to be longitudinally curved, Applicant submits that claim 11 specifies a shape distinctly different from that of the bowed portion 32 of MYERS. Clearly, such shape cannot be made via the extrusion technique disclosed by MYERS. As explained in column 5, lines 44-47 of MYERS, "[e]xtrusion processes can be highly efficient

and cost effective manufacturing techniques for articles that are shaped suitable for extrusion, such as a shape defining a constant cross-section ...." A curve that extends longitudinally cannot be made by extrusion.

Further, pressing a longitudinally curved intermediate section into a flange of MYERS's frame would not have been obvious to one skilled in the art. MYERS discloses a straight frame, resulting from an extrusion technique. There would appear to be no reason and no advantage in providing a longitudinally curved intermediate frame section in MYERS' frame.

Further, the limitation of Applicant's claim 11 is somewhat similar to the limitation appearing in Applicant's *allowed* claim 15 of a rib that extends longitudinally other than in a straight line.

For this additional reason, Applicant requests that the rejection of claim 11 be reversed.

At least in view of the foregoing, Applicant requests that the rejection based upon MYERS be withdrawn.

### **C. New Claims 31-38**

As mentioned above, new claims 31-36 refer, with varying degrees of specificity, to the subject matter described on page 9, lines 15-16 of Applicant's specification, in which the flanges of the chassis have L-shaped transverse sections and in which the flanges are connected together by the small arm of each "L".

Being made by extrusion, the chassis of the MYERS skate is not made in more than a single extruded part. In addition, there is no disclosure in MYERS that teaches or suggests the manufacture of a frame in more than a single part. Still further, it would not have been obvious to have made MYERS' frame in more than a single part and maintain consistency with the objectives set forth by MYERS.

Accordingly, claims 31-36 are allowable at least for these reasons, in addition to the reasons given above regarding the claims from which they depend.

New claim 37 depends from independent claim 9 and refers to each of the lateral and medial intermediate portions having at least an outwardly raised segment that extends and varies in height lengthwise. The "bulged or bowed portion 32" (column 6, line 20) of MYERS, which is extends outwardly in a central (intermediate) portion of side walls 25, 26 does not vary in height. Instead, as can be seen in Figs. 1 and 2, the portions 32 of MYERS extend straight and horizontally, not varying in height lengthwise.

Lastly, new independent claim 38 is similar to claim 1, but adds the word "single" in the final subparagraph (*i.e.*, "said stiffening rib having been made by pressing, extending longitudinally other than in a *single* straight line").

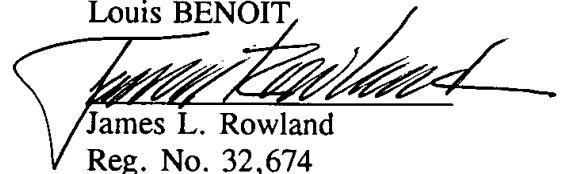
### **SUMMARY AND CONCLUSION**

The sole ground of rejection advanced in the Office action has been addressed and is believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

A check is enclosed for payment of a claim fee and a fee for an extension of time. The Commissioner is authorized to charge any additional fee required for acceptance of this reply as timely and/or complete to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone number given below.

Respectfully submitted,  
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Attachment: Replacement sheet of drawing